<u>REMARKS</u>

I.   STATUS OF THE CLAIMS

Claims 1-20 are pending. Claims 1-6, 11, 21 and 22 were rejected under 35 U.S.C. §

103(a) (hereinafter, "Section 103 (a)") as being unpatentable over McDowell et al., (U.S.

Patent Publication No. 2001/0034224, hereinafter, "McDowell") in view of Dennis,

(PCT/US98/26785, hereinafter, "Dennis") and further in view of Ilsen et al., (U. S. Patent No.

6,757,898, hereinafter "Ilsen").

Claims 7, 9, 10, 12-16, 17 and 19 were rejected under Section 103 (a) as being

unpatentable over McDowell, Dennis and Ilsen and further in view of Patil (U.S. Pat. No.

6,625,460, hereinafter, "Patil").

Claim 8 was rejected under Section 103 (a) as being unpatentable over McDowell,

Dennis and Ilsen and further in view of Smith et al. (U.S. Pat. No. 6,333,973, hereinafter,

"Smith").

Claims 18 and 20 were rejected under Section 103(a) as being unpatentable over

McDowell, Dennis, Ilsen and Patil and further in view of Smith.

Applicant respectfully traverses all rejections and requests reconsideration.

A. REJECTION UNDER SECTION 103 (a), McDowell in view of Dennis and Ilsen

Claims 1-6, 11, 21 and 22 were rejected under Section 103(a) as being unpatentable

over McDowell in view of Dennis and further in view of Ilsen. In rejecting the independent

claims 1 and 11 as being unpatentable over McDowell, Dennis and Ilsen, the Examiner stated

that McDowell teaches all the claim limitations of claims 1 and 11 but does not teach

"registering or tentatively registering an account over a computer network and confirming the

registering of the prospective user associate with a direct request to register form the

prospective user." The Examiner further stated that Dennis provides the deficiency of

McDowell and "therefore it would have been obvious to combine the art of McDowell with

the teaching of Dennis which teaches registering or tentatively registering an account over a

computer network and confirming the registering of the prospective user associated with a

direct request to register from the prospective user to provide a system and method for users

to control the delivery or information to a wireless device and control services provided to the

device". (Office Action, pg. 3-4).

Examiner further stated that McDowell and Dennis do not teach "automatically

allocating a unique identifier to the prospective user" and "sending notification of said unique

identifier to said prospective user at the client specific address of the prospective user, either

confirming the registration of the prospective user if the initial receiving was associated with

a direct request to register from the prospective user; or inviting registration of the prospective

user if the initial receiving was associated with a request to register from someone other than

the prospective user". Examiner also stated that Ilsen teaches the above-mentioned elements

of Applicant's claims. (Office Action, pg. 4)

Applicant respectfully traverses Examiner's rejection as explained below.

As explained in M.P.E.P. Section 706.02(j):

> *To establish a prima facie case of obviousness, three basic criteria must be met.
> First, there must be some suggestion or motivation, either in the references themselves or in
> the knowledge generally available to one of ordinary skill in the art, to modify the reference
> or to combine reference teachings. Second, there must be a reasonable expectation of*

success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The three above-mentioned criteria must exist at the time the claimed invention was made, according to the text of Section 103(a) itself. The Examiner has not established a prima facie case of obviousness using McDowell, Dennis and Ilsen for at least the reasons stated below.

<u>McDowell, Dennis and Ilsen</u>

McDowell discusses a system and method for sharing user event information among mobile devices and those connected to fixed IP networks such as the Internet. (McDowell, Abstract). It is basically an online presence detection system for already registered users with the system. (McDowell, par. 0030-0031). There is no mention of registering or tentatively registering an account for a user. There is also no mention of confirmation of registration. Further, McDowell indeed does not teach assignment of unique identifier to a prospective user of an IM system, nor automatic allocation of the unique identifier to the prospective user.

Dennis discloses a system for collecting and management of personal information via a wireless terminal. (Dennis, Abstract) The user establishes a personal profile on a network, such as the Internet, and the profile is used to determine which types of information should be sent to the wireless device. (Dennis, pg. 3, lines 4-6). The process for establishing a personal profile is disclosed as a new user being "presented with a different screen on his/her first connection to the personal profile website. The new user screen could be used to initiate a new account. The new user would be prompted for information such as name, e-mail address, billing information, future long-in ID and password, wireless service

provider and wireless telephone number." (Dennis, pg. 10, lines 6-10). However, by opening

this account, Dennis makes no mention of unique identifying numbers, not to mention

automatic allocation of such unique identifying numbers.

Ilsen discusses a system for providing automated, electronic communications between

a health-care provider and a plurality of users for the purpose of providing a simple, reliable

and effective interface for rapidly exchanging inquiries, responses, data, services and

information between the both parties for the mutual benefit and satisfaction of each. (Ilsen,

col. 1, lines 6-12) Ilsen makes no mention of automatic allocation of unique identifiers to

prospective users of the system. It also does not teach matching of unique identifier to client

specific access address of prospective user. Neither does Ilsen provide for the remaining

elements of the claims.

1. REFERENCES DO NOT TEACH OR SUGGEST ALL CLAIM LIMITATIONS

McDowell, Dennis, Ilsen, Claims 1 and 11

Applicant's claim 1 and claim 11 require at least "receiving a client specific access

address of a **prospective user** on the computer network **together with** a request to register or

tentatively register an account for said prospective user; "**automatically** allocating a unique

identifier to the prospective user". The claims also require "matching said unique identifier to

the client specific access address of the prospective user". None of these elements are taught

in McDowell, contrary to Examiner's citing of paragraph 0030. (Office Action, pg. 3).

McDowell is clearly a system for existing, already registered users of the system. Therefore,

McDowell nowhere teaches the receipt of a "client specific access address for a prospective

user on the computer network together with a request to register or tentatively register an

account". McDowell, in paragraph [0029] states that "when a cellular telephone user turns on his telephone, an event trigger is initiated and recorded in the HLR...The HLR informs the MES of the event and relays...data that constitutes a subscriber record at the HLR." The act of turning on a mobile phone does not constitute the claimed element. There is no disclosure of "receiving a client specific address of a prospective user" and neither is it "together with a request to register or tentatively register an account". Applicant respectfully requests that the Examiner point out where, in the language of McDowell paragraph [0030], all the claim limitations are recited. The paragraph refers to registered users or "subscribers". McDowell teaches that the user is not a "prospective user", but already a part of the system, having an "instant messaging list" setup. (McDowell, par. 0030).

Furthermore, neither is there any "automatically allocating a unique identifier to the prospective user" nor any "matching said unique identifier to the client specific access address of the specific user" not to mention any "storing the matched unique identifier and client specific access address with said IM server under the unique identifier". McDowell in fact does not recite a "unique identifier" anywhere as cited by Examiner in paragraph [0030]. Rather, McDowell discloses broadcasting a telephone user's presence to various services and determines whether other subscribers are on-line, based on the user's list, and then informs the user of the presence of other subscribers on-line. (McDowell, par. 0030). Again, McDowell fails to disclose the requirements of claims 1 and 11 as its system is not an initial registration method but rather an online presence detection system for already registered users with the system. (McDowell, par. 0030-0031). It is apparent that McDowell fails to teach the required limitations of the claims.

Dennis fails to provide the deficiencies of McDowell. It is understood that Examiner has not used Dennis to supply the deficiencies as outlined above, but only to supply the incomplete elements in piecemeal of "registering or tentatively registering an account for said prospective user..." and "confirming the registering of the prospective user if the initial receiving was associated with a direct request to register from the prospective user". However, because McDowell fails to provide a number of missing elements of claims 1 and 11, it is argued that Dennis also fails to provide them as described below.

Dennis is a system that discusses initiating a new account, however, the process when used in combination with McDowell, fails to teach all the claim limitations of Applicant's Claims 1 and 11. Dennis teaches a new account initiation when a user goes to a web site for setting up a personal profile, "a new user would be presented with a different screen on his/her first connection" and the "new user would be prompted for information" (Dennis, pg. 10, lines 6-9). However, nowhere does Dennis teach "receiving a client specific access address of a prospective user" and "automatically allocating a unique identifier to the prospective user" and further nowhere is there a "registering or tentatively registering an account for said prospective user by storing the matched unique identifier and client specific access address with said IM server under the unique identifier". Dennis discloses presenting a screen to the user and further prompting the user for information for the account setup. At most in Dennis, after an account is created, the personal profile web site displays screen 30 which identifies the user that has logged-in by listing the account holder's name and the type of account. (Dennis, pg. 10, lines 6-14). Contrary to Examiner's assertion, it is apparent that Dennis fails to disclose "tentatively registering an account". Applicant respectfully requests Examiner to point out where there is taught "tentatively registering an account". Dennis does

not provide the limitations of claims 1 and 11, as mentioned, there is no receiving of a client specific <u>access address</u>...and neither, contrary to Examiner's assertion, does Dennis teach the complete element of "confirming the registering of the prospective user" through "sending notification...at the <u>client specific address</u>".

Ilsen fails as well in providing the deficiencies of McDowell and Dennis. Examiner mentions that McDowell and Dennis do not teach automatic allocation of a unique identifier to the prospective user. However, Examiner asserts that Ilsen teaches this limitation. (Office Action, pg. 4). Nonetheless, after careful study, it is shown that Ilsen does not teach, either expressly or inherently, automatic allocation of unique identifier to a prospective user of an IM system. Ilsen requires that either the patient or the provider (by previous entry in a data file) supply the social security number, and medical record or other unique identifying number that would constitute the unique identifier for the user. (Ilsen, Col. 30, line 12-21). Thus, actual identifiers of a user in Ilsen are a social security number and other unique identifying numbers, as these identifiers are used in the system to correlate to the patient's records, and these numbers are not automatically generated, but supplied by the user. (Ilsen, Col. 30, lines 12-15). In addition, it is only when a database checks for the existence of the patient in a "repository" population table, populated by the practice's office, and then when "two unique identifiers both match a record in the repository", is the user assigned a unique user name and password. (Ilsen, Col. 30, lines 16-25). This disclosure in no manner supports the requirement of claims 1 and 11 of "<u>automatically</u> allocating a unique identifier to the prospective user;" and "matching said unique identifier to the client specific access address of the prospective user". In fact, there is no <u>prospective user</u> of the system, but rather existing patients who have repository records on file. In addition, there is no automatic allocation of

anything "if an exact match cannot be found for the user who has signed up" (Ilsen, col. 30, lines 31-32). Thus, unlike Applicant's invention there is no means in Ilsen for automatic allocation of unique identifier to <u>prospective users</u> of the system, i.e. unregistered users. Ilsen just authenticates the identity of its existing patients; it does not assign a registration identity for prospective users of an IM system. Thus, none of the references McDowell, Dennis or Ilsen, in combination teach "automatic allocation of a unique identifier to the prospective user".

Applicant's claims 1 and 11 also require "sending notification of said unique identifier to said **prospective user** at the client specific address of the **prospective user,** either: **confirming** the registering of the prospective user if the initial receiving was associated with a direct request to register form the prospective user; or **inviting** registration of the prospective user if the initial receiving was associated with a request to register **from someone other than the prospective user**". Examiner asserts that both McDowell and Dennis fail to provide such elements and turns to Ilsen providing for these elements in Col. 30, lines 22-26. (Office Action, pg. 4). However, Ilsen discloses only that "a 'welcome on-line' e-mail message to the user with instructions for first-time login" is sent. (Col. 30, lines 25-26). Such an "e-mail message" sent to the user does NOT teach that a notification has been sent to a "prospective user at the client specific address of the prospective user". For one thing, the user of Ilsen, is not a "prospective user" as required by claim 1, but rather, the user is an "existing patient" whose identification is already in a record in a repository. (Ilsen, col. 30, lines 16). Secondly, as required in claims 1 and 11 along with "confirming the registering of the prospective user" the notification alternatively "**invites** registration of the

- 14 -

prospective user if the initial receiving was associated with a request to register **from someone other than the prospective user**". This element of "inviting registration" of the "prospective user" when the request to register is "from someone other than the prospective user" is in no manner disclosed in Ilsen. As mentioned, the action in Ilsen is made by an existing patient, NOT a "prospective user" and neither is there any support as asserted by Examiner in col. 30, lines 22-26, of "inviting registration" in the event the "request to register [is] from someone other than the prospective user".

Thus, none of the references McDowell, Dennis or Ilsen teach at least sending notification of unique identifier to the prospective user at client specific address of the prospective user, either: confirming registering via a direct request from the prospective user or inviting registration via a request to register from someone other than the prospective user.

Therefore, McDowell in light of Dennis and in further light of Ilsen fail to teach or suggest ALL claim limitations as required to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 1 and 11 under Section 103(a).

2. NO SUGGESTION OR MOTIVATION, EITHER IN THE REFERENCES THEMSELVES OR IN THE KNOWLEDGE GENERALLY AVAILABLE TO ONE OF ORDINARY SKILL IN THE ART, TO MODIFY THE REFERENCE OR TO COMBINE REFERENCE TEACHINGS

There is no motivation or suggestion to modify or combine the teachings of Ilsen with those of McDowell and Dennis to obtain the limitations of the claims of an authorization/registration system for an IM application for prospective users. The nature of the problem to be solved by Applicant would not lead one to use Ilsen as a reference dealing

with a medical patient interface system and neither would one use McDowell which deals

with operation of an IM system <u>following registration</u>. These references are concerned with

very different problems to be solved. Both McDowell and Ilsen deal with already existing

users of a system. In McDowell, as described by Examiner in the Office Action, pg. 3, there

is no direct or tentative registration taught for a prospective user and neither does Ilsen deal

with direct or tentative registration for a prospective user. In fact, there is no <u>prospective user</u>

of the system, but rather existing patients who have repository records on file. Accordingly,

there is no suggestion or motivation in Ilsen to provide for direct or tentative registration for a

prospective user or even be combined with McDowell which is in no manner dealing with

registration.

Furthermore, there is no suggestion or motivation to combine McDowell and Ilsen

with Dennis which provides for a new user to initiate a new account. McDowell deals with

existing users, Ilsen requires exiting patients to login only upon a match of two identifiers to a

record. To combine teachings of McDowell and Ilsen with Dennis would render one of

Dennis' purposes of initiating a new account unsatisfactory as well as change the principle of

initiating a new account inoperable. Ilsen's requirement for a match in a repository would

teach away from allowing a new user to open an account in Dennis by requiring the user to

have had information saved in a repository.

In addition, none of the references have any motivation to be combined in providing

for the claimed element of "<u>automatically</u> allocating a unique identifier to a prospective user".

As mentioned, McDowell has no automatic allocation anywhere, neither does Dennis, and in

fact, Ilsen does not provide automatic allocation of anything "if an exact match cannot be

found for the user who has signed up" (Ilsen, col. 30, lines 31-32). Thus, Ilsen <u>teaches away</u>

from automatic allocation of a unique identifier by teaching that the limitation is simply not automatic, but *conditional* on information matched to *already exiting user information as shown by database*. Ilsen requires the user to be, in a sense, "pre-registered" and identified by the system before an automatic username and password are allocated to the user. Thus, unlike Applicant's invention, there is no means in Ilsen for automatic allocation of a unique identifier to prospective users of the system, i.e. unregistered users. Ilsen just authenticates the identity of its existing patients; it does not assign a registration identity for prospective users of an IM system. Thus, there is no objective reason to combine the references McDowell, Dennis or Ilsen, for obtaining the limitation of "automatically allocating a unique identifier to the prospective user".

Moreover, as mentioned above, none of the references teach the limitations of "tentatively registering an account" or "inviting registration" let alone "if the initial receiving was associated with a request to register from someone other than the prospective user." Neither is there any motivation or suggestion apparent in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to provides for such limitations. McDowell deals with no registration (not prospective users), Dennis deals with direct registrations (not tentative and not invited) and Ilsen deals with direct registrations of existing patients (not tentative, not invited and not prospective users). Accordingly, no prima facie case of obviousness can be established for claim 1.

Thus, two of the three elements required for a rejection under Section 103(a) are missing with regard to claims 1 and 11. The lack of any one of the three elements would make claims 1 and 11 allowable over the teachings of McDowell and Dennis in light of Ilsen.

- 17 -

The above-described actual lack of two elements even more clearly makes claims 1 and 11 allowable over McDowell, Dennis and Ilsen.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 1 and 11 under Section 103(a).

Claims 2-6

Dependent claims 2-6 include all limitations of their respective base claim 1. Accordingly, Applicant respectfully submits that these dependent claims are all allowable for at least the same reasons as are their respective base claim. Furthermore, Applicant respectfully submits that these dependent claims are further allowable for the limitations that they themselves recite. For instance regarding claim 2, it is asserted by Examiner that McDowell teaches that the "unique identifier is a UIN" in paragraph 0030, (Office Action, pg. 5). However, Applicant has reviewed the reference and nowhere in McDowell is there a mention of a unique identifier being a UIN.

Applicant respectfully disagrees with the assertions regarding the dependent claims from the Office Action. The assertions have been made moot by the above discussion of the base claims.

Claims 21 and 22

Applicant has already withdrawn claims 21 and 22 through amendment dated August 26, 2004. Thus, it is respectfully requested that rejections to claims 21 and 22 be withdrawn.

B. REJECTION UNDER SECTION 103(a), over McDowell, Dennis, Ilsen and in further view of Patil.

Claims 7, 9, 10, 12-16, 17 and 19 depend on and include all limitations of their respective base claims 1, 7 and 17. Claims 7 and 17 each depend on respective base claim 1. The deficiencies of McDowell, Dennis and Ilsen have been discussed above in connection with claim 1. However, Patil simply does not supply the deficiencies of McDowell, Dennis and Ilsen. Accordingly, Applicant respectfully submits that claims 7, 9, 10, 12-16, 17 and 19 are allowable for at least the same reasons as is claim 1.

In addition, it is held that Patil may discuss an SMS method where messages can be sent to members of a distribution list composed of different address types (Dennis, col. 4, lines 48-50). However, Patil is devoid of any suggestion or motivation for combination with the other cited references in providing for the claimed limitations of a method or system for assigning a unique identifier to a prospective user of an IM system. Applicant's claimed invention <u>as a whole</u> is not obvious.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 7, 9, 10, 12-16, 17 and 19 under Section 103(a).

C. REJECTION UNDER SECTION 103(a), McDowell, Dennis, Ilsen in further view of Smith

Claim 8 depends on and includes all limitations of respective base claim 1. The deficiencies of McDowell, Dennis and Ilsen have been discussed above in connection with claim 1. Smith does not supply the deficiencies of McDowell, Dennis and Ilsen.

In addition, it is held that Smith may discuss a message handling system where

- 19 -

messages of all types can be accessed form a central location (Smith, Abstract) However,

Smith is devoid of any suggestion or motivation for combination with the other cited

references in providing for the claimed limitations of a method for assigning a unique

identifier to a prospective user of an IM system. Applicant's claimed invention as a whole is

not obvious.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claim 8

under Section 103(a).

D. REJECTION UNDER SECTION 103(a), McDowell, Dennis, Ilsen, Patil in further view
of Smith

Claim 18 and 20 depend on and include all limitations of their respective base claim 7

and 17. Claims 7 and 17 each depend on respective base claim 1. The deficiencies of

McDowell, Dennis, Ilsen and Patil have been discussed above in connection with claim 1.

Smith does not supply the deficiencies of McDowell, Dennis, Ilsen and Patil.

Both Smith and Patil are devoid of any suggestion or motivation for combination with

the other cited references in providing for the claimed limitations of a system for assigning a

unique identifier to a prospective user of an IM system. Applicant's claimed invention as a

whole is not obvious.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 18

and 20 under Section 103(a).

II.   CONCLUSION

The above-discussed remarks are believed to place the present Application in

condition for allowance. Should the Examiner have any questions regarding the above

amendments, the Examiner is requested to telephone Applicant's representative at the number

listed below.

Respectfully submitted,

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